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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,295	10/19/2001	Harris Bergman	1378-1-1	2101
25207	7590	09/14/2005	EXAMINER	
POWELL GOLDSTEIN LLP ONE ATLANTIC CENTER FOURTEENTH FLOOR 1201 WEST PEACHTREE STREET NW ATLANTA, GA 30309-3488			TOMASZEWSKI, MICHAEL	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,295

Applicant(s)

BERGMAN ET AL.

Examiner

Mike Tomaszewski

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice To Applicant

1. This communication is in response to the application filed on 19 October 2001.

Claims 1-2 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 2 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

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(A) For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena that do not apply, involve, use, or advance technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, exemplary claim 2 is drawn to a method for managing medical information comprising the steps of “collecting...”, “reducing...”, “compressing”, “extracting...”, “processing...”, “retrieving...”, and “displaying...”. It is not clear whether or not the recited steps of collecting, reducing, compressing, extracting, processing, retrieving, and displaying actively apply, involve, use, or advance the technological arts. In particular, these acts are capable of being performed in the human mind or via paper and pencil. As such, there is no specific requirement with the language of the claim to a practical application WITHIN the technological arts, as there is no requirement for any of the recited steps to be performed electronically or via computerized database components.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, exemplary claim 2 is drawn to a method of managing medical information, and as such, appears to produce a useful, concrete, and tangible result, namely a means for effectively managing medical information.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 2 is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

(A) Claim 1 recites "...as shown and described in the above description." and therefore, is an omnibus type claim.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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(A) Regarding Claim 1, it is unclear what the claimed system actually comprises in terms of components.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Illiff (6,022,315; hereinafter Illiff).

(A) As per Claim 1, Illiff discloses a system for storing medical information and deploy applications using the Internet (Illiff: col. 8, lines 33-35; col. 4, lines 46-58; Fig. 1).

Insofar as Applicant fails to properly set forth the metes and bounds of the omnibus phrase "as shown and described in the above description," it is immaterial whether or not Illiff meets such a limitation.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Illiff in view of Ballantyne (5,867,821; hereinafter Ballantyne) and further in view of Wang (6,266,435; hereinafter Wang).

(A) As per Claim 2, Illiff discloses a method for managing medical information, comprising:

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- (a) collecting patient records and/or demographic data (Illiff: col. 13, lines 57-61); and
- (b) reducing said data (Illiff: col. 78, lines 8-10) (Examiner considers extracting data to read on reducing data.).

Illiff, however, fails to expressly disclose a method for managing medical information, comprising:

- (c) compressing said data;
- (d) extracting the features of data in the form of images;
- (e) processing and storing said data;
- (f) retrieving said data; and
- (g) displaying and/or reporting said data.

Nevertheless, some of these features are old and well known in the art, as evidenced by Ballantyne. In particular, Ballantyne discloses a method for managing medical information, comprising:

- (c) compressing said data (Ballantyne: col. 2, lines 28-32).

One of ordinary skill would have found it obvious at the time of the invention to include the aforementioned features of Ballantyne within the Illiff system with the

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motivation of providing a more automated system for distribution and administration of medical services, electronic health records and the like. (Ballantyne: col. 1, lines 57-60)

The combined teachings of Illiff and Ballantyne, however, fail to expressly disclose a method for managing medical information, comprising:

- (d) extracting the features of data in the form of images;
- (e) processing and storing said data;
- (f) retrieving said data; and
- (g) displaying and/or reporting said data.

Nevertheless, the above features are old and well known in the art, as evidenced by Wang. In particular Wang discloses a method for managing medical information, comprising:

- (d) extracting the features of data in the form of images (Wang: col. 5, lines 40-48);
- (e) processing and storing said data (Wang: col. 6, lines 20-24);
- (f) retrieving said data (Wang: col. 6, lines 22-23); and
- (g) displaying and/or reporting said data (Wang: col. 7, lines 38-39).

One of ordinary skill would have found it obvious at the time of the invention to include the aforementioned features of Wang with the combined teachings of Illiff and

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Ballantyne with the motivation of providing additional medical data (e.g., the predictive data pertaining to CAD-detected abnormalities) as an aid to radiologists, radiologic technicians, or other users (Wang: col. 3, lines 50-55).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied art teaches a remote access medical image exchange system and methods of operation therefor (6,006,191); an image data management system particularly for use in a hospital (5,586,262); a system and method for adaptive transmission of information (US 2002/0099569); and an apparatus and method for processing and/or for providing healthcare information and/or healthcare-related information (6,283,761).

The cited but not applied prior art also includes non-patent literature articles by Ralph T. King, Jr. ("Image Medical Lets Radiologists Perform Their Work From Afar" Nov. 18, 1999. Wall Street Journal. pg. B.10.) and Business Editors/Hi-Tech Writers ("Radiology.com Redefine Healthcare By Converging Dicom and Java Technology Company Enables Majority of Industry to Participate in Digital Imaging" Mar. 7, 2000. Business Wire. pg. 1.).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MT



9.7.2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600